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No. 386

In the
Supreme Court of the United States
October Term, 1967

STEWART-WARNER CORPORATION,
Petitioner,

vs.

BISHMAN MANUFACTURING CO. and GEORGE T. HEMMETER,
Respondents.

PETITIONER'S REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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Two passages in respondents' brief inadvertently expose the basic fallacy—and inherent evil—in the decision sought to be reviewed by the petition for certiorari in this case.

In the first passage, respondents candidly admit that the original claims in the Hemmeter application were too broad to be valid. As respondents put it:

> "There is no denying that Hemmeter's original claim 11 (R. 378) can be read on petitioner's balancer. But what of it? The claim as thus filed was clearly invalid for numerous reasons including the one that it was too broad . . ." (Respondents' Brief, p. 5).

In the second passage, respondents nevertheless maintain there is no file wrapper estoppel in this case because "the 'axial spacing' expression was never even mentioned in the Patent Office as a condition for the allowance of the claim" held valid and infringed by the District Court and Court of Appeals (Respondents' Brief, p. 6).

Thus, respondents argue—and the Court of Appeals has held—that any phrase or expression not mentioned in the file history as a condition for allowance of the patent can be expanded, through the doctrine of equivalents, to have the same scope as a broader phrase appearing in a cancelled claim which was admittedly too broad to be valid.

This, of course, is the very result the doctrine of file wrapper estoppel was designed to prevent.

The decisions of *this* Court make it clear that the doctrine was not meant to be limited to claim phrases or expressions which were required by the Patent Office or mentioned in the file history as a condition for allowance of the patent. For example, *Schriber-Schroth Co.* v. *Cleveland Trust Co.* (1940), 311 U.S. 211, held that an estoppel existed in a case where the file history contained no indication of the reason for allowance of the claims in issue, with the Court expressly stating:

> "*. . . it does not appear why the patent office allowed the broad claims after rejecting the narrower ones.* But in any case, the patentee, having acquiesced in their rejection, is no longer free to gain the supposed advantage of the rejected claims by a construction of the allowed claims as equivalent to them . . ." (311 U.S. 221-222; emphasis supplied).

In short, there *is* a decisional conflict between the Courts of Appeals for the Seventh and Fifth Circuits, on the one hand, and this Court and the Courts of Appeals for the Second and Ninth Circuits, on the other, and respondents cannot make that conflict disappear simply by asserting it does not exist.

Conclusion

Respondents have not denied that the doctrine of equivalents is invoked to establish infringement in a majority of the cases in which infringement is an issue, and that file wrapper estoppel defenses are asserted in over half of those cases.

The need for uniformity in this area of the law—and the need for an objective standard for determining whether a file wrapper estoppel exists in a particular case—are accordingly clear.

The rule now being applied in the Seventh and Fifth Circuits is, however, incapable of objective application; it requires an inquiry into the patentee's *motives or reasons* for inserting each phrase or expression into the patent claims.

Unless this Court requires the Courts of Appeals to put the law of file wrapper estoppel back on its historical disclaimer basis, the doctrine may soon pass out of the law completely, for the Patent Office has recently begun the practice of permitting amendments and allowing claims after nothing more than a telephone interview between the Examiner and the applicant's attorney.* In such cases, there is no formal Patent Office action and, hence, no basis on which one can even *speculate* as to the reasons for the claim amendments. As a result, there could never be a file

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* Two Patent Office notices relating to the telephone interview practice are set forth in the appendix to this brief.

wrapper estoppel in such a case, under the rule now being applied in the Seventh and Fifth Circuits.

Petitioner urgently requests the Court to grant certiorari in this case.

Respectfully submitted,

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APPENDIX

Telephone Numbers on Amendments and Other Papers

In view of the increased use of telephone interviews regarding matters which can be readily cleared up by a telephone call to applicant or his representative, it is again recommended that amendments and other papers, such as letters of transmittal, include the complete telephone number with area code and extension, preferably near the signature of the writer.

RICHARD A. WAHL,
Assistant Commissioner.

Mar. 11, 1966.

Interview Practice Preliminary to Notice Under 35 U.S.C. 132

Effective Sept. 1, 1967 the following practice will be initiated in the Patent Office on a six months experimental basis:

If, upon review of a *new* application at the time it is reached for examination, the Examiner determines that *all* claims are not in allowable condition but that most of them are allowable or can be corrected to be made allowable, applicant's attorney or agent will be so notified by letter accompanied by copies of the most pertinent references found in a search of the prior art. Within approximately one week from the date of the letter, the Examiner will contact the attorney or agent by telephone for purposes of discussing the merits of the application if in the interim other disposition of the application has not been made.

This practice is designed to facilitate early agreement between applicant's representative and the Examiner in defining the allowable subject matter. The practice should result in early disposition of applications in which the Examiner determines that allowable subject matter is present. For purposes of the written record applicant may file a paper at any time prior to submission of the issue fee wherein he points out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited.

Examiners will continue the present practice of calling applicants or their representatives for discussion in *new* applications in which the application of prior art is not at issue or is only a very minor problem, and there is accordingly no necessity for furnishing copies under the above procedure.

RICHARD A. WAHL,
Assistant Commissioner.

July 11, 1967.